



05-29-04
Walker & Jocke
a legal professional association

AF
3621

Ralph E. Jocke

Patent
&
Trademark Law

May 18, 2004

Mail Stop Appeal Brief - Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

RECEIVED
MAY 26 2004
GROUP 3500

Re: Application Serial No.: 09/193,565
Confirmation No.: 2182
Art Unit: 3621 (Examiner Pierre Eddy Elisca)
Appellants: Jay Paul Drummond, et al.
Title: Automated Banking Machine and System
Docket No.: D-1077+2

Sir:

Please find enclosed the 2nd Supplemental Appeal Brief of Appellants pursuant to 37 C.F.R. § 1.192 in triplicate, in response to the Action dated February 26, 2004, for filing in the above-referenced application.

No fee is deemed required. However, the Commissioner is authorized to charge any necessary fee associated with the filing of the 2nd Supplemental Appeal Brief and any other fee due to Deposit Account 09-0428.

Very truly yours,

Ralph E. Jocke
Reg. No. 31,029

CERTIFICATE OF MAILING BY EXPRESS MAIL

I hereby certify that this document and the documents indicated as enclosed herewith are being deposited with the U.S. Postal Service as Express Mail Post Office to an addressee in an envelope addressed to Mail Stop Appeal Brief - Patents, Commissioner for Patents, PO Box 1450, Alexandria, VA 22313-1450 this 19th day of May 2004.

EV382415835US
Express Mail Label No.

Ralph E. Jocke

330 • 721 • 0000
MEDINA

330 • 225 • 1669
CLEVELAND

330 • 722 • 6446
FACSIMILE

rej@walkerandjocke.com
E-MAIL

231 South Broadway, Medina, Ohio U.S.A. 44256-2601



D-1077+2

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re Application of:
Jay Paul Drummond, et al.
Serial No.: **09/193,565**
Confirmation No.: **2182**
Filed: **November 17, 1998**
For: **Automated Banking
Machine and System**

RECEIVED
Art Unit 3621 MAY 26 2004
GROUP 3600
Patent Examiner
Pierre Eddy Elisca

Mail Stop Appeal Brief - Patents
Commissioner for Patents
PO Box 1450
Alexandria, VA 22313-1450

**2nd SUPPLEMENTAL BRIEF OF APPELLANTS
PURSUANT TO 37 C.F.R. § 1.192**

Sir:

The Appellants hereby respectfully request reinstatement of the appeal pursuant to 37 C.F.R. § 1.193(b)(2). The Appellants hereby submit their Second Supplemental Appeal Brief pursuant to 37 C.F.R. § 1.192, in triplicate, concerning the above-referenced Application.

REAL PARTY IN INTEREST

The Assignee of all right, title and interest to the above-referenced Application is Diebold, Incorporated, an Ohio corporation.

RELATED APPEALS AND INTERFERENCES

Appellants believe that there are no related appeals or interferences pertaining to this matter.

STATUS OF CLAIMS

Claims 1-20 are pending in the Application.

Claims 1-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Wagner (US 5,742,845) in view of Anderson, et al. (US 5,706,442) (hereinafter "Anderson").

These rejections were the only rejections present in the Office Action ("Action") dated February 26, 2004. Appellants appeal each claim rejection, inclusive.

STATUS OF AMENDMENTS

No final rejection is pending. However, claims have been rejected numerous times, including non final Office Actions due to prosecution reopenings. Therefore, no amendments to the claims were requested to be admitted after a final rejection.

The following dates and papers are associated with this application:

1. 09/19/01 Office Action (Final Rejection)
2. 12/17/01 Notice of Appeal
3. 02/13/02 Appeal Brief
4. 05/07/02 Examiner's Answer
5. 06/07/02 Petition -- impermissible new rejection in the Examiner's Answer
6. 06/10/02 Reply Brief
7. 02/25/03 Office Action with Final Rejection
8. 04/01/03 Petition -- premature final rejection in the 02/25/03 Office Action
9. 06/12/03 Non-final Office Action with prosecution reopened
10. 09/05/03 Supplemental Appeal Brief
11. 02/26/04 Non-final Office Action with prosecution reopened

As the prosecution history shows, prosecution was reopened following a supplemental appeal brief (which had followed an earlier reopening after an Examiner's Answer). Appellants strongly desire to proceed with their appeal to prevent even further unnecessary prosecution delay by the Office. Each of the petitions is considered by the Appellants as having been fully answered by the Office. Thus, no petitions are outstanding. Furthermore, as shown in more detail herein, Appellants' claims are allowable over the new grounds of rejection applied in the Action. Thus, Appellants respectfully request reinstatement of their appeal pursuant to 37 C.F.R. § 1.193(b)(2).

In light of the Office's habit of reopening of prosecution, Appellants reserve the right to further expound on the issues and address the rejections after an Examiner's Answer has been written. That is, until the drifting cloud of further rejections and prosecution reopenings and new

rejections has passed, it would be unreasonable (and an undue burden) to expect Appellants to explain the issues in fine detail. Appellants will address the arguments presented in the Examiner's Answer in their Reply Brief. Regardless, Appellants provide sufficient reasons herein why the pending claims are allowable.

The current Action (dated February 26, 2004) indicates that the "new" prior art (i.e., Wagner) was found during an "updated search." However, this explanation seems improbable. An "updated search" includes reviewing only newly available art, such as newly issued patents in a class/subclass previously searched. An "updated search" is an update of a search previously made according to MPEP § 719.05 (II) (C) (Eighth Edition, August 2001; Rev. 1, Feb. 2003). The Wagner reference is not a newly issued patent. Wagner was actually issued before the pending application was even filed. Thus, it is unclear how Wagner could have been found in an "updated search." The Office has provided no other (valid) explanation or evidence. Instead, it appears that the Office has purposely gone outside of the normal bounds of searching during prosecution of Appellants' application, which would constitute arbitrary and capricious action.

SUMMARY OF INVENTION

Overview of the Invention

An exemplary form of the invention is directed to an automated transaction machine, such as an ATM. The ATM is associated with a computer. To accommodate the situation where a user desires to conduct a transaction that is not available with the ATM, software executable in the computer can provide an appropriate display message to the user to indicate that the transaction is not available. The software can include a browser which enables the ATM to

access HTML documents through a network. These documents can include a display reference corresponding to the availability of the transaction function devices in the ATM.

The exemplary ATM can include a function which checks for the availability of each type of transaction function device within the machine. Information indicative of the available transaction devices can be generated by the ATM. This information can be directed from the ATM to a server. The server can provide to the ATM appropriate HTML documents which correspond to the types of transactions that the ATM is capable of performing. As a result the ATM can avoid the presentation to users of screen displays produced responsive to HTML documents which include references to transaction types that the machine is not capable of performing. For example, an ATM may normally accept deposits, but its depository has become full. In that situation the ATM can change the documents it accesses, to present an updated display message to users accurately reflecting that the deposit option is no longer offered.

Documents selectively delivered through a network to an ATM in exemplary embodiments may be static documents or may be generated at run time from sub-documents, to provide appropriate outputs and/or instructions through a screen and/or other output devices of the ATM. Thus, the ATM may adjust its operation and customer interface to respond to changing conditions.

CONCISE STATEMENT OF THE ISSUES PRESENTED FOR REVIEW

The questions presented in this appeal are whether Appellants' claims 1-20 are unpatentable under 35 U.S.C. § 103(a) over Wagner in view of Anderson.

GROUPING OF CLAIMS

No groups of claims stand or fall together. Reasons are provided in the Argument section herein. The arguments presented hereafter provide reasons why each of the claims is separately patentable. Appellants present for each respective separate claim a corresponding respective separate argument as to why the claim is patentable over the rejection applied thereto. Reasons are provided how each claim recites additional features of the invention which distinguishes the claim over every other pending claim. Reasons are further provided how each of the claims recites at least one element, combination of elements, or step not found or suggested in the applied references, which patentably distinguishes each claim.

The rejected claims include four independent claims (claims 1, 7, 10, and 19). Claims 2-6 and 13-14 depend from claim 1. Claims 8-9 and 15-16 depend from claim 7. Claims 11-12 and 17-18 depend from claim 10. Claim 20 depends from claim 19. All pending claims 1-20 are reproduced in the Appendix.

ARGUMENT

The Applicable Legal Standards

Before a claim may be rejected on the basis of obviousness pursuant to 35 U.S.C. § 103, the Patent Office bears the burden of establishing that all the recited features of the claim are known in the prior art. This is known as *prima facie* obviousness. To establish *prima facie* obviousness, it must be shown that all the elements and relationships recited in the claim are known in the prior art. If the Office does not produce a *prima facie* case, then the Appellants are

under no obligation to submit evidence of nonobviousness. MPEP § 2142 (Eighth Edition, August 2001; Rev. 1, Feb. 2003).

The teaching, suggestion, or motivation to combine the features in prior art references must be clearly and particularly identified in such prior art to support a rejection on the basis of obviousness. It is not sufficient to offer a broad range of sources and make conclusory statements. *In re Dembiczak*, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999).

Even if all of the features recited in the claim are known in the prior art, it is still not proper to reject a claim on the basis of obviousness unless there is a specific teaching, suggestion, or motivation in the prior art to produce the claimed combination. *Panduit Corp. v. Denison Mfg. Co.*, 810 F.2d 1561, 1568, 1 USPQ2d 1593 (Fed. Cir. 1987). *In re Newell*, 891 F.2d 899, 901, 902, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989).

The evidence of record must teach or suggest the recited features. An assertion of basic knowledge and common sense not based on any evidence in the record lacks substantial evidence support. *In re Zurko*, 258 F.3d 1379, 59 USPQ2d 1693 (Fed. Cir. 2001).

A determination of patentability must be based on evidence of record. *In re Lee*, 277 F.3d 1338, 61 USPQ2d 1430 (Fed. Cir. 2002).

It is respectfully submitted that the Action from which this appeal is taken does not meet these burdens.

Wagner

Wagner is directed to a system for extending present open network communication protocols to communicate with non-standard I/O devices coupled to an open network. The

system (10) includes a Web server (12) which is coupled to an open network (14) such as the Internet for communication with various non-standard I/O devices (16, 18, 20, 32, 34, 36, 38) (Figure 1; col. 9, line 63 to col. 10, line 1). The system permits a consumer to collect product information by using an open network, such as the Internet, and then use a more secure transaction link for the transaction (col. 6, lines 12-16; col. 18, lines 26-36). A client program executes in a non-standard I/O device (col. 10, lines 52-54). For a payment transaction the client program is suspended and control is transferred to a conventional bank processing application. Printer (38) prints a purchase agreement form (e.g., charge slip) for the customer's signature (col. 5, lines 3-8; col. 18, lines 33-36; col. 19, lines 27-28). Thus, a conventional secure proprietary transaction system for authorization and settlement can be maintained (col. 11, lines 58-65).

The system permits a user to use the open network for non-confidential communication such as collecting product information, pricing, and product availability. This information may be collected quickly and efficiently using the extended Internet protocol. The conventional bank processing program and more secure communication links may then be used for the confidential information required to carry out the transaction. Thus, Wagner seeks to combine the features and advantages of the Internet with the more secure communication link and data security enhancing devices of systems presently known (col. 7, lines 15-25).

Anderson

Anderson is directed to a system for delivering financial information. Anderson's "Conductor" system is a sophisticated computer software system based on distributed system technology (col. 1, lines 56-57). The distributed system includes a Conductor system

architecture network. The system works to provide timely financial information to users. The system permits users to review activity and balances relating to their accounts. For example, the system permits a user to use a PC to "access information regarding recent account activity or their account balances" (col. 1, lines 12-14) "so that users may review activity and balances" (col. 2, line 1). Anderson's financial information service system is capable of servicing (fulfilling) financial information requests (col. 5, lines 24-47; col. 6, lines 19-23). The information requests are related to the viewing of account information, such as recent debit card transactions (col. 5, lines 24-47). The requested financial information may be transmitted back to the user (col. 5, lines 28-31; col. 1, lines 52-55). Anderson's service enables a user to check or verify their bill payments.

(iv) 35 U.S.C. § 103

Appellants traverse the rejections on the grounds that Appellants' claims recite features, relationships, and/or steps which are neither disclosed nor suggested in the prior art, and because there is no teaching, suggestion, or motivation cited so as to produce Appellants' invention. The features, relationships, and/or steps recited in Appellants' claims patentably distinguish over the applied reference(s).

To establish *prima facie* obviousness, the prior art references must teach or suggest all the claim limitations. MPEP § 2142. Absent a showing of a teaching, suggestion, or motivation to produce a claimed combination, an obviousness rejection is not proper.

Appellants respectfully submit that none of the applied reference(s), taken alone or in combination, disclose or suggest the features, relationships, and/or steps that are specifically

recited in the claims. Additionally, even if it were somehow possible for the reference(s) to have disclosed certain features as alleged, it still would not have been obvious to have combined the reference(s) as alleged. Furthermore, even if it were somehow possible for the reference(s) to be combined as alleged, the resultant combination still would not have produced Appellants' claimed invention.

The Office has not established a *prima facie* showing of obviousness. Therefore, the Appellants respectfully submit the rejections are improper and should be withdrawn.

**The Claims Are Not Obvious Over
Wagner in view of Anderson**

Claims 1-20 were rejected under 35 U.S.C. § 103(a) as obvious over Wagner in view of Anderson. These rejections are respectfully traversed.

Appellants' previous remarks (in the Supplemental Appeal Brief filed September 5, 2003) regarding the patentability of claims 1-20 with respect to Anderson are incorporated herein by reference. For reasons presented in the previously filed Supplemental Appeal Brief, Anderson cannot alleviate the admitted and discussed deficiencies of Wagner (which are discussed in more detail herein) as it does not teach or suggest the recited features which are not found in Wagner.

Claim 1

In an exemplary embodiment, the claimed apparatus has the flexibility to change the operation and customer interface of an ATM to respond to changing machine conditions (e.g., Specification page 37, line 20 to page 38, line 10; and page 18, line 5 to page 19, line 6). Conditions may change so that certain transaction functions are not available. For example, a

machine may have the ability to accept deposits until its depository is full. Then the machine may change the HTML documents it accesses to display different messages to users so that the deposit option is no longer offered. As a result the machine avoids displaying documents which include references to transactions which are not available. Hence, in the exemplary embodiment, the machine would be able to access a (different) HTML document which corresponds to the current availability of the transaction function devices in the machine.

Wagner is directed to a system that permits a consumer to collect product information by using an open network, such as the Internet, and then use a different, more secure transaction link for the transaction. Note the above description of Wagner. Anderson is directed to permitting users to view current account information. Note the above description of Anderson. Anderson is not concerned with the ability to carry out a transaction function in the manner recited in claim 1.

The Action (on page 3, last paragraph) admits that Wagner fails to teach or suggest software executable in a computer, especially where the software includes a browser. The Action further admits that Wagner fails to teach or suggest a computer that "operates the browser to access an HTML document responsive to the type of transaction function device in the machine."

The Office previously admitted (on page 3 of the Office Action dated June 12, 2003) that Anderson fails to teach or suggest an automated transaction machine located at a first location. The Office also previously admitted that Anderson fails to teach or suggest at least one available transaction function device, where each respective available transaction function device is selectively operative to carry out a respective different type of transaction function.

The Action alleges that Anderson teaches a system for on-line financial transaction services, wherein a user may communicate with a financial application via a Web text markup

language (HTML). The Action further alleges that it would have been obvious to modify "the ATM's machine of Wagner by including a HTML as taught by Anderson because this would assist users or customers in a common level." The Appellants respectfully disagree.

As previously mentioned, the Office admits that Wagner fails to teach or suggest the recited software, especially software that can cause an HTML document corresponding to the available transaction function devices in the machine to be accessed. As previously mentioned, the Office has also admitted that Anderson fails to teach or suggest an automated transaction machine having at least one available transaction function device. By inference, Anderson (by lacking reference to transaction function device availability) also lacks software that can cause the accessing of a document related to transaction function device availability. It follows that by the Office's own admission, both Wagner and Anderson do not teach or suggest the recited software. As all of the claim features have not been shown in the prior art, the Office has not established a *prima facie* showing of obviousness. Because the Office has not produced a *prima facie* case of obviousness, Appellants are under no obligation to submit evidence of nonobviousness (MPEP § 2142). Nevertheless, Appellants will expand on why neither Wagner nor Anderson, taken alone or in combination (i.e., the references), teach or suggest an automated transaction machine including at least one available transaction function device, a computer, and software in the manner recited.

Appellants respectfully submit that the references lack more of the recited features and relationships than the Office admits. The references do not teach or suggest an automated transaction machine with the capability to access an HTML document which corresponds to the availability of the transaction function devices in the automated transaction machine. Where are

the references concerned about the availability of automated transaction machine transaction function devices? Where do the references teach or suggest software capable of enabling a machine computer to access an HTML document which corresponds to the availability of transaction function devices in the automated transaction machine? The references do not correlate transaction function devices available in an automated transaction machine to a particular accessed document.

The references lack any teaching or suggestion whatsoever of determining available transaction function devices. It follows that the references lack the capability to access an HTML document based on the available transaction function devices in a machine. Where do the references teach or suggest software capable of enabling a machine computer to access an HTML document which is based on the availability of transaction function devices in the machine?

Furthermore, the references are not concerned with the type of transaction function that can be carried out by a respective available transaction function device. There is nothing in the references that links an HTML document to different types of available transaction functions. The references do not teach or suggest using an HTML document that corresponds to hardware status (the availability of transaction function devices). Nor do the references teach or suggest an automated transaction machine with the ability to access an HTML document corresponding to hardware in the machine that is available to be operated.

Neither Wagner nor Anderson link the status of transaction function devices in an automated transaction machine to an HTML document. The references do not teach or suggest software that can enable an automated transaction machine to access the corresponding transaction function devices availability document. Where are the references even concerned

with transaction function device availability? Where do the references have the capability to access the status of transaction function devices via a corresponding HTML document?

Where do the references relate to an automated transaction machine, where available machine transaction function devices are selectively operative to carry out respective different types of transaction functions, and where machine software is operative to enable a machine computer to access the HTML document that is in accordance with the availability of the transaction function devices in the machine? The references do not teach or suggest the recited apparatus.

The Action is silent as to what specific features in the references allegedly constitute the recited features. As best understood, the Action (on page 3, lines, 5-6) alleges that a credit card terminal in Wagner is "equivalent to" an automated transaction machine located at a first location. Furthermore, best understood, the Action alleges that an ATM in Wagner constitutes a transaction function device because an "ATM performs different type of function" (on page 3, lines 16-17) and "modify the ATM's machine" (on page 4, line 6). The Appellants respectfully disagree with the Office's interpretation of Wagner. Regardless, claim 1 recites that an automated transaction machine includes at least one available transaction function device in the machine. Thus, even if it were somehow possible for Wagner to have a credit card terminal as an automated transaction machine, the credit card terminal (the alleged automated transaction machine) does not include an ATM (the alleged transaction function device) therein.

The Office distorts the teachings of Wagner by selectively taking them out of context. For example, the Action alleges that in Wagner a "transaction may include special purpose devices such as automatic teller machines (ATMS), point of sale terminals, credit card terminal."

However, the correct interpretation of Wagner can be found at col. 1, lines 25-28, which states "Transaction computers may include special purpose devices such as automatic teller machines (ATMs), point of sale (POS) terminals, credit card terminals, and screen phone terminals."

Wagner does not teach or suggest that a single transaction includes all of the mentioned devices, as the Action alleges. Rather, these devices are examples of transaction computers. Also, if these devices are transaction computers (according to Wagner), then what constitutes a computer in Wagner that is in operative connection with each transaction function device?

The attempts in the Action to modify what Wagner actually teaches are clearly attempts at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, 22 USPQ2d 1780 (Fed. Cir. 1992). The rejection, which lacks the necessary evidence and rationale, is based on knowledge gleaned only from Appellants' disclosure.

The Action is devoid of any prior art teaching, suggestion, or motivation to combine features so as to have produced the claimed invention. Furthermore, even if it were somehow possible to combine features in the references (which it isn't) this would not render the resultant combination obvious because neither reference suggests the desirability of the combination. Without a proper motivation in the prior art to combine features, which is the current situation, the rejection is improper (MPEP § 2143.01).

Wagner uses "an extended open system protocol that supports communication with devices that are not personal computers" (Abstract). Wagner is concerned with communication between devices, where at least one of the devices is a non-standard input/output (I/O) device. Anderson is concerned with a person (10) using their personal computer (Figure 1) to obtain

financial information. Anderson appears to use standard I/O device communication. Thus, Wagner has no use for Anderson's standard I/O teaching. Contrarily, Anderson teaches away from Wagner's desire to support I/O operations for non-standard I/O devices. Nor does the Action explain how Wagner could have been modified with the teaching of Anderson to have produced the recited invention. Since the Action does not explain the rejection with reasonable specificity, it also procedurally fails to establish a *prima facie* case of obviousness. *Ex parte Blanc*, 13 USPQ2d 1383 (Bd. Pat. App. & Inter. 1989).

Furthermore, it appears that such an alleged modification to Wagner would destroy the disclosed and desired utility and operability of the Wagner teaching. That is, the alleged modification to Wagner would render the reference inoperable for its intended and desired purpose (i.e., non-standard I/O device communication). However, an obviousness rejection cannot be based on a combination of features in references if making the combination would result in destroying the utility or advantage of the device shown in the prior art reference. *In re Fine*, 5 USPQ2d 1598-99 (Fed. Cir. 1988).

Appellants have shown that the references do not teach or suggest the recited features and relationships. The Action has not established that all of the recited features are known in the prior art. The Action lacks substantial evidence support. *In re Zurko*, supra. Thus, the Action does not factually support any *prima facie* conclusion of obviousness. It would not have been obvious to one having ordinary skill in the art to have modified Wagner with the teaching of Anderson in the manner alleged to have produced the recited apparatus. The alleged modification of Wagner (if somehow even possible) would not have resulted in the recited

features and relationships. Therefore, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection of claim 1 is improper and should be withdrawn.

Claim 2

Claim 2 depends from claim 1. The references further do not teach or suggest an automated transaction machine computer with the ability to operate a browser to access an HTML document by generating an address, where at least a portion of the address is indicative of at least one of the types of transaction function devices in the machine. Where do the references teach or suggest generating an address indicative of a type of transaction function device included in an automated transaction machine? Where do the references teach or suggest anything indicative of any type of transaction function device included in any automated transaction machine? Where do the references generate an address indicative of a type of transaction function device? Where do the references link an address to transaction function device type? The Office has not established a *prima facie* showing of obviousness. It would not have been obvious to one having ordinary skill in the art to have modified Wagner in the manner alleged to have produced the recited invention.

Claim 3

Claim 3 depends from claim 1. The relied upon sections of the references do not teach or suggest a depository. The references do not teach or suggest an automated transaction machine including a transaction function device having a depository. Thus, the Office has not established a *prima facie* showing of obviousness. In an exemplary embodiment of the recited invention, the apparatus has a banking depository (44) for accepting deposits into a secure location in the automated transaction machine.

Claim 4

Claim 4 depends from claim 1. The references further do not teach or suggest that a server is operative to deliver a document responsive to the availability of a particular type of transaction function device in an automated transaction machine. The references do not teach or suggest anything about the availability of a transaction function, nor the availability of a particular type of transaction function device, nor that a server is operative to deliver a document responsive to the availability of the particular type of transaction function device. The Office has not established a *prima facie* showing of obviousness.

Claim 5

Claim 5 depends from claim 4. The references further do not teach or suggest an automated transaction machine having an available transaction function device including a sheet dispenser, and not having an available transaction function device including a depository for carrying out deposit transactions. The Action is silent as to where the references teach or suggest a sheet dispenser in an automated transaction machine. The Action is also silent as to where the references teach or suggest an automated transaction machine with an available sheet dispenser but without an available depository. The basis and motivation for the stated rejection are absent from the record. Appellants respectfully decline to speculate. A statement of rejection must be explained with reasonable specificity, otherwise the Action procedurally fails to establish a *prima facie* case of obviousness. *Ex parte Blanc*, supra. The Office has not established a *prima facie* showing of obviousness.

Claim 6

Claim 6 depends from claim 4. The references further do not teach or suggest an automated transaction machine including a sheet dispenser and a depository. Nor do the references teach or suggest a document (deliverable by a server) that includes reference to both a dispense transaction and a deposit transaction. The Action is silent as to where the references teach or suggest a sheet dispenser, depository, and document. The Appellants respectfully decline to speculate. The Office has not established a *prima facie* showing of obviousness.

Claim 7

For reasons of brevity, note Appellants' remarks in support of the patentability of claim 1. For reasons previously discussed (and reasons discussed in more detail herein), it would not have been obvious to one having ordinary skill in the art to have modified Wagner with the teaching of Anderson in the manner alleged in the Action to have produced the recited apparatus.

The Action admits that Wagner does not teach or suggest the recited software including a browser, nor the ability to deliver an HTML document in the manner recited. The Office previously admitted (on page 6 of the Office Action dated June 12, 2003) that Anderson fails to teach or suggest an output device. Appellants respectfully submit that the references do not teach or suggest more of the recited features and relationships than the Office admits.

The references do not teach or suggest an automated transaction machine computer in operative connection with a memory that includes data representative of a plurality of transaction function devices in the automated transaction machine. Nor do the references teach or suggest the recited relationship of a machine computer, server, browser, and output device. Nor do the references teach or suggest the ability to communicate representative data to a server which is

operative, responsive to receipt of the data, to deliver an HTML document to a browser, and where a computer is operative responsive to the HTML document to operate an output device. Where do the references relate operation of an output device of an automated transaction machine to data representative of a plurality of transaction function devices of the automated transaction machine? Where do the references teach or suggest operating an output device responsive to an HTML document? Where do the references link automated transaction machine output device operation (via a browser and a server) to a plurality of the machine's transaction function devices?

The Action is silent as to where the references teach or suggest memory including "device data" representative of a plurality of transaction function devices in an automated transaction machine. The Action is also silent as to how the references are able to communicate this memory data to a server to obtain an HTML document for output device operation. The Action is further silent as to where the references teach or suggest an automated transaction machine computer that is operative responsive to an HTML document to operate an output device. The Action is silent as to where the relied upon references teach or suggest the recited features and relationships. Nor do the references teach or suggest the recited features and relationships.

The Action asserts that it is obvious for an ATM in Wagner to include an output device for dispensing cash or paper. By inference the Office admits that Wagner does not teach or suggest an output device. As previously discussed, the Office has admitted that Anderson fails to teach or suggest an output device. It follows that the Office has admitted that the relied upon references do not teach or suggest the recited output device. That is, the Office has admitted that the evidence of record does not teach or suggest all of the recited features. However, the

evidence of record must teach the recited features and relationships to present a valid rejection.

The rejection lacks substantial evidence support. *In re Zurko*, supra. Nor is the determination of patentability in the Action based on evidence of record. *In re Lee*, supra.

Appellants also traverse and challenge the Action's assertion that it is obvious for an ATM in Wagner to include an output device for dispensing cash or paper. Where is there any indication that cash or paper dispensing is necessary or mandatory in Wagner. Nor has the Office proved that every ATM is able to dispense cash or paper. It follows that the record is absent the evidence necessary for modifying Wagner in the manner alleged. Anderson cannot alleviate the admitted deficiencies of Wagner as it does not teach or suggest (as the Office has admitted) the recited features which are not found in Wagner. Appellants respectfully submit that the record lacks the requisite supporting evidence to sustain the rejection. Appellants respectfully submit that because the rejection is based on mere assertions and not proper evidence of record, it is not a valid rejection.

Nevertheless, even if it were somehow possible (by neglecting the Office's admission and the affirming lack of evidence of record) for Wagner to have an output device for dispensing cash or paper, there would still be no indication that the output device would be operated responsive to an HTML document. That is, Wagner (by somehow having an output device) still would not teach or suggest an automated transaction machine having an output device related with an HTML document in the manner recited.

The attempts to modify Wagner are clearly attempts at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, supra. The Action is devoid of any valid

motivation in the prior art to combine features so as to have produced the claimed invention.

Even if it were somehow possible to combine features in the references this would not render the resultant combination obvious because the references do not suggest the desirability of the combination (MPEP § 2143.01). Thus, the rejection is improper and should be withdrawn.

Appellants respectfully submit that neither Wagner nor Anderson, taken alone or in combination, teach or suggest the recited features and relationships. The Office has not established a *prima facie* showing of obviousness. In light of the admitted and discussed failures of the references to teach all of the recited features and relationships, combined with the lack of any other supporting evidence of record, the rejection is not valid. It would not have been obvious to have modified Wagner with Anderson in the manner alleged to have produced the claimed invention. The rejection is improper and should be withdrawn.

Claim 8

Claim 8 depends from claim 7. The references further do not teach or suggest an automated transaction machine computer that is operative responsive to an HTML document to operate a machine output device, especially where the HTML document includes instructions to operate the device. Where do the references teach or suggest an HTML document that includes output device operating instructions? The Office has not established a *prima facie* showing of obviousness.

Claim 9

Claim 9 depends from claim 7. The references further do not teach or suggest server software in the manner recited. The references do not teach or suggest server software that is operative to generate an HTML document responsive to the receipt of data representative of a

plurality of transaction function devices of an automated transaction machine. The references do not teach or suggest the ability to communicate data (representative of a plurality of transaction function devices of an automated transaction machine) to a server which is operative to generate (responsive to receipt of the data) and deliver an HTML document to a browser, where a computer is operative responsive to the HTML document to operate an output device. The Office has not established a *prima facie* showing of obviousness. Thus, it would not have been obvious to have modified Wagner with Anderson in the manner alleged to have produced the claimed invention.

Claim 10

Claim 10 is an independent method claim. For reasons of brevity, note Appellants' remarks in support of the patentability of claim 1. For reasons previously discussed (and reasons discussed in more detail herein), it would not have been obvious to one having ordinary skill in the art to have modified Wagner with the teaching of Anderson in the manner alleged to have produced the recited method. Appellants respectfully submit that neither Wagner nor Anderson, taken alone or in combination, teach or suggest the recited features, relationships, and steps.

The Action (on page 3, last line) admits that Wagner does not teach or suggest the ability "to access an HTML document responsive to the type of the transaction function device in the machine." The Office previously admitted (on page 3 of the Office Action dated June 12, 2003) that Anderson fails to teach or suggest at least one transaction function device, where each transaction function device can carry out a different type of transaction function.

The references do not teach or suggest the ability to provide first and second HTML documents nor the ability to access either the first or the second document in the manner recited.

The Action is silent as to the references teaching or suggesting plural HTML documents that include a respective reference. Appellants respectfully submit that the references do not teach or suggest a first HTML document having a first reference to a first transaction type carried out by a first transaction function device. Nor do the references teach or suggest a second document having a second reference to a second transaction type carried out by a second transaction function device. It follows that the references do not teach or suggest the recited first and second HTML documents. It further follows that the references, without the recited first and second HTML documents, cannot teach or suggest the recited providing step.

The references also do not teach or suggest the recited accessing step. Where do the references link the selection of a particular HTML document to the types of transactions available in an automated transaction machine? The references do not teach or suggest choosing which (first or second) HTML document to access based on which transaction function devices are included in an automated transaction machine.

There is no teaching or suggestion of an automated transaction machine in the references that is capable of having more than one condition or arrangement of transaction function devices. Where do the references teach or suggest a machine having different transaction function device conditions? Where do the references teach or suggest a machine having a condition that includes a first transaction function device but not a second transaction function device? Where do the references teach or suggest a machine having another condition that includes both of the first and second transaction function devices? Where do the references teach or suggest accessing either a first document or a second document depending on the particular condition of a machine's transaction function devices? The references do not teach or suggest accessing either a first

document when an automated transaction machine includes a first transaction function device but not a second transaction function device, or a second document when the machine includes both the first and the second transaction function devices.

The references do not teach or suggest the ability to determine which HTML document to access based on which transaction function devices an automated transaction machine includes. In the combined teachings of the references there is no relationship of accessing a particular document based on which transaction function devices a machine includes. It follows that the references cannot teach or suggest the recited accessing step.

The attempts to modify Wagner are clearly attempts at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, supra. The Action is devoid of any valid motivation in the prior art to combine features so as to have produced the claimed invention. Even if it were somehow possible to combine features in the references this would not render the resultant combination obvious because the references do not suggest the desirability of the combination (MPEP § 2143.01). Thus, the rejection is improper and should be withdrawn.

Appellants respectfully submit that the rejection is not valid due to the references' failure to teach or suggest all of the recited features, relationships, and steps, along with the lack of any other supporting evidence of record. The Office has not established a *prima facie* showing of obviousness. Nor would it have been obvious to one having ordinary skill in the art to have modified Wagner with the teaching of Anderson in the manner alleged to have produced the recited method. The rejection is improper and should be withdrawn.

Claim 11

Claim 11 depends from claim 10. As previously discussed, the references do not teach or suggest the recited accessing step. It follows that the references further do not teach or suggest accessing a first document at a first address, or accessing a second document at a second address. The Office has not established a *prima facie* showing of obviousness.

Claim 12

Claim 12 depends from claim 10. The relied upon sections of the references fail to teach or suggest the recited features, relationships, and steps. The references do not teach or suggest delivering device data (representative of transaction function devices included in an automated transaction machine) to a server. Nor do the references teach or suggest that a document accessed in the accessing step is accessed responsive to the device data. The Action is silent as to the references teaching or suggesting device data in the manner recited. The Action is silent as to correlating the accessing of a particular document with device data of transaction function devices. The references do not teach or suggest accessing either a first or second HTML document based on data representative of transaction function devices in an automated transaction machine. The Office has not established a *prima facie* showing of obviousness. Nor would the alleged modification of Wagner (if somehow even possible) have resulted in the recited features, relationships, and steps.

Claim 13

Claim 13 depends from claim 1. The Action is silent as to where the references teach or suggest a currency dispenser device adapted to selectively dispense currency from an automated transaction machine. As previously discussed (e.g., remarks in support of the patentability of

claim 7), by inference the Office admits that Wagner does not teach or suggest a currency dispenser device. Nor does Anderson teach or suggest a currency dispenser device. Thus, Anderson cannot alleviate the deficiencies of Wagner as it does not teach or suggest the recited features which are not found in Wagner. It follows that it would not have been obvious to one having ordinary skill in the art to have modified Wagner in the manner alleged to have produced the recited apparatus.

Claim 14

Claim 14 depends from claim 1. The Action again is silent concerning any prior art teaching of the recited features and relationships. The Action is silent as to where the references teach or suggest an automated transaction machine including a card reader transaction function device, a currency dispenser transaction function device, a depository transaction function device, and a receipt printer device. The Appellants respectfully decline to speculate. The Office has not established a *prima facie* showing of obviousness. Nor is there any evidence of record that Wagner's system is capable of including the recited features and relationships. It would not have been obvious to one having ordinary skill in the art to have modified Wagner in the manner alleged to have produced the recited apparatus.

Claim 15

Claim 15 depends from claim 7. The Action is silent as to where the references teach or suggest a currency dispenser device adapted to selectively dispense currency from an automated transaction machine. As previously discussed (e.g., remarks in support of the patentability of claim 13), the references do not teach or suggest a currency dispenser device. Nor is there any evidence of record that Wagner's system is capable of dispensing currency. It follows that it

would not have been obvious to one having ordinary skill in the art to have modified Wagner in the manner alleged to have produced the recited apparatus.

Claim 16

Claim 16 depends from claim 7. The Action is silent as to where the references teach or suggest an automated transaction machine including a card reader transaction function device, a currency dispenser transaction function device, a depository transaction function device, and a receipt printer transaction function device. As previously discussed (e.g., remarks in support of the patentability of claim 14), the references do not teach or suggest the recited features and relationships. Nor is there any evidence of record that Wagner's system is capable of including the recited features and relationships. It follows that it would not have been obvious to one having ordinary skill in the art to have modified Wagner in the manner alleged to have produced the recited apparatus.

Claim 17

Claim 17 depends from claim 10. As previously discussed, the references do not teach or suggest a currency dispenser device or a depository device. The Office has not established a *prima facie* showing of obviousness. It follows that the references cannot teach or suggest accessing either a first document when an automated transaction machine includes a currency dispenser device but not a depository device, or a second document when the machine includes both a currency dispenser device and a depository device. It would not have been obvious to one having ordinary skill in the art to have modified Wagner in the manner alleged to have produced the recited method.

Claim 18

Claim 18 depends from claim 10. The Action is silent concerning the recited features and relationships. The Action is silent as to where the references teach or suggest first and second transaction function devices from among a card reader device, a currency dispenser device, a depository device, and a receipt printer device. As previously discussed, the references do not teach or suggest the devices. Nor is there any evidence of record that Wagner's system is capable of including the recited features and relationships. It would not have been obvious to one having ordinary skill in the art to have modified Wagner in the manner alleged to have produced the recited method.

Claim 19

Claim 19 is an independent method claim. For reasons of brevity, note Appellants' remarks in support of the patentability of claims 1 and 10. For reasons previously discussed (and reasons discussed in more detail herein), it would not have been obvious to one having ordinary skill in the art to have modified Wagner with the teaching of Anderson in the manner alleged to have produced the recited method. Appellants respectfully submit that neither Wagner nor Anderson, taken alone or in combination, teach or suggest the recited features, relationships, and steps.

The Action is silent concerning where the recited features, relationships, and steps are found in the references. Nor do references teach or suggest the recited features, relationships, and steps. It follows that the Office has not established a *prima facie* showing of obviousness.

As previously discussed (e.g., remarks in support of the patentability of claim 10), the references do not teach or suggest conditions of transaction function devices in an automated

transaction machine. It follows that the references do not teach or suggest availability conditions of transaction function devices in an automated transaction machine. Nor are the references concerned with first and second availability conditions of transaction function devices. It follows that there is no teaching or suggestion in the references of an automated transaction machine that has more than one availability condition.

The Action is also silent as to the references teaching or suggesting plural documents including a respective display reference. Nor is there any teaching or suggestion in the references directed to documents including a display reference corresponding to an availability condition of transaction function devices. Nor is there any teaching or suggestion in the references of accessing (with a browser) either a first or a second document based on whether an automated transaction machine has a first or a second availability condition. Where do the references teach or suggest accessing either a first or second document based on the availability condition of an automated transaction machine? Where do the references teach or suggest choosing which (first or second) display reference to access contingent on which availability condition resides in an automated transaction machine? Nor do the references teach or suggest providing a display corresponding to the document accessed. Where do the references teach or suggest providing an output display in the manner recited? Where do the references link a display (via a browser and a network-accessible document) to the availability condition of transaction function devices in an automated transaction machine? The references, taken alone or in combination, do not teach or suggest many of the recited features, relationships, and steps.

As previously discussed, the references do not teach or suggest all of the recited steps, features, and relationships. Even if it were somehow possible to modify Wagner with the

teaching of Anderson as alleged, the modified Wagner would still lack the recited steps, features, and relationships. For example, the modified Wagner would still lack the capability of providing a display corresponding to a document that was accessed based on the availability of automated transaction machine transaction function devices. Regardless, even if it were somehow possible to combine features in the references this would not render the resultant combination obvious because the references do not suggest the desirability of the combination (MPEP § 2143.01). The Action is devoid of any prior art teaching, suggestion, or motivation to combine features so as to have produced the claimed invention.

As previously discussed (e.g., remarks in support of the patentability of claim 1), the alleged modification to Wagner would destroy the disclosed and desired utility and operability of the Wagner teaching. However, an obviousness rejection cannot result in destroying the utility or advantage of the Wagner teaching. *In re Fine*, supra.

The attempts to modify Wagner are clearly attempts at hindsight reconstruction of Appellants' claimed invention, which is legally impermissible and does not constitute a valid basis for a finding of obviousness. *In re Fritch*, supra. The Action is devoid of any valid motivation in the prior art to combine features so as to have produced the claimed invention. Without a proper motivation in the prior art to combine features, which is the current situation, the rejection is improper (MPEP § 2143.01). Thus, the rejection is improper and should be withdrawn.

Appellants have shown that the references do not teach or suggest the recited features, relationships, and steps. Nor would it have been obvious to one having ordinary skill in the art to have modified Wagner with the teaching of Anderson in the manner alleged. Nor would the

alleged modification of Wagner (if somehow even possible) have resulted in Appellants' recited invention. Therefore, Appellants respectfully submit that the 35 U.S.C. § 103(a) rejection should be withdrawn.

Claim 20

Claim 20 further recites that the machine includes a currency dispenser transaction function device. As previously discussed (e.g., remarks in support of the patentability of claim 13), the references do not teach or suggest a currency dispenser transaction function device. The Office has not established a *prima facie* showing of obviousness. Nor is there any evidence of record that Wagner's system is capable of or needs to dispense currency. It would not have been obvious to one having ordinary skill in the art to have modified Wagner in the manner alleged to have produced the recited invention.

CONCLUSION

As explained above, each of the claims specifically recites feature, relationships, and/or steps that are neither disclosed nor suggested in the applied art. Furthermore, the applied art is devoid of any such teaching, suggestion, or motivation for combining features of the applied art so as to produce Appellants' invention. For these reasons it is respectfully submitted that all the pending claims are allowable.

Respectfully submitted,



Ralph E. Jocke
WALKER & JOCKE
231 South Broadway
Medina, Ohio 44256
(330) 721-0000

Reg. No. 31,029

APPENDIX

CLAIMS

1. Apparatus comprising:

an automated transaction machine located at a first location, wherein the machine includes:

at least one transaction function device in the machine, wherein the at least one transaction function device includes at least one available transaction function device, wherein each respective available transaction function device is selectively operative to carry out a respective different type of transaction function;

a computer, wherein the computer is in operative connection with each transaction function device;

software executable in the computer, wherein the software includes a browser, wherein the software is operative to enable the computer to access an HTML document which corresponds to the availability of the transaction function devices in the machine.

2. The apparatus according to claim 1 wherein the machine includes different types of transaction function devices, and wherein the computer operates the browser to access the document by generating an address, and wherein at least a portion of the address is indicative of at least one of the types of transaction function devices included in the machine.

3. The apparatus according to claim 1 wherein the machine includes a transaction function device including a depository.

4. The apparatus according to claim 1 and further comprising a server, wherein the server is operative to deliver at least one document to the browser, wherein the document is delivered responsive to the availability of a particular type of transaction function device in the machine.

5. The apparatus according to claim 4 wherein the particular type of transaction function device in the machine includes a sheet dispenser, and wherein the machine does not include an available transaction function device including a depository for carrying out deposit transactions, and wherein the one document delivered by the server includes no reference to a deposit transaction.

6. The apparatus according to claim 4 wherein the available transaction function devices in the machine include a sheet dispenser for carrying out a dispense transaction and a depository for carrying out deposit transactions, and wherein the one document the server is operative to deliver to the browser includes a reference to both a dispense transaction and a deposit transaction.

7. Apparatus comprising:

an automated transaction machine including:

a plurality of types of transaction function devices, wherein each type of transaction function device is selectively operative to carry out a transaction function;

at least one output device, wherein an output device is selectively operative to provide user outputs;

a computer, wherein the computer is in operative connection with a memory, the output device and each of the transaction function devices, and wherein the memory includes device data representative of a plurality of transaction function devices in the machine;

software executable in the computer, wherein the software includes a browser;

a server in operative connection with the computer, and a plurality of HTML documents deliverable through the server;

wherein the computer is operative to communicate data representative of the device data to the server and wherein the server is operative responsive to receipt of the device data to deliver at least one HTML document to the browser for processing wherein the computer is operative responsive to the one HTML document to operate the output device.

8. The apparatus according to claim 7 wherein the one document includes instructions to operate at least one device, and wherein the computer is operative responsive to the one document to operate the device.

9. The apparatus according to claim 7 and further comprising server software in operative connection with the server, wherein the server software is operative to generate the one document responsive to the receipt of the data representative of the device data.

10. A method comprising the steps of:

providing a plurality of HTML documents, wherein each of the documents is accessible through a server, wherein a first document includes a first reference, wherein the first reference is to a first transaction type carried out by a first transaction function device, and wherein a second document is accessible through the server and includes a second reference, wherein the second reference is to a second transaction type carried out by a second transaction function device; and

accessing with a browser operating in a computer in an automated transaction machine, either the first or the second document wherein the first document is accessed when the machine includes the first transaction function device but not the second transaction function device, and wherein the second document is accessed when the machine includes both the first and the second transaction function devices.

11. The method according to claim 10 wherein the accessing step includes accessing the first document at a first address, or accessing the second document at a second address.

12. The method according to claim 10 and prior to the providing step further comprising the step of delivering to the server from the machine device data representative of the transaction function devices included in the machine, wherein the document accessed in the accessing step is accessed responsive to the device data.

13. The apparatus according to claim 1 wherein the at least one available transaction function device in the machine includes a currency dispenser device, wherein the currency dispenser device is adapted to selectively dispense currency from the machine, wherein the computer is in operative connection with the currency dispenser device.

14. The apparatus according to claim 1 wherein the machine includes a card reader transaction function device, a currency dispenser transaction function device, a depository transaction function device, and a receipt printer transaction function device.

15. The apparatus according to claim 7 wherein a transaction function device includes a currency dispenser device in the machine, wherein the currency dispenser device is adapted to selectively dispense currency from the machine, wherein the computer is in operative connection with the currency dispenser device.

16. The apparatus according to claim 7 wherein the machine includes a card reader type of transaction function device, a currency dispenser type of transaction function device, a depository type of transaction function device, and a receipt printer type of transaction function device.

17. The method according to claim 10 wherein the first transaction function device includes a currency dispenser device, and the second transaction function device includes a depository device.

18. The method according to claim 10 wherein the first and second transaction function devices are selected from among a card reader transaction function device, a currency dispenser transaction function device, a depository transaction function device, and a receipt printer transaction function device.

19. A method comprising the steps of:

providing an automated transaction machine including

a computer with a browser, and

a plurality of transaction function devices,

providing a plurality of documents, wherein each of the documents is accessible through a network,

wherein a first document includes a first display reference, wherein the first display reference corresponds to a first availability condition of transaction function devices in an automated transaction machine,

wherein a second document includes a second display reference, wherein the second display reference corresponds to a second availability condition of transaction function devices in an automated transaction machine,

accessing with the browser either the first or the second document,

wherein the first document is accessed when the provided automated transaction machine corresponds to the first availability condition, and

wherein the second document is accessed when the provided automated transaction machine corresponds to the second availability condition,

providing a display to an output device, wherein the display corresponds to the document accessed.

20. The apparatus according to claim 19 wherein the machine includes a currency dispenser transaction function device in the machine.